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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,098	07/08/2003	Teunis Dekker	ISCAT-005A	8653

7590 05/10/2007
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EXAMINER

HANLEY, SUSAN MARIE

ART UNIT	PAPER NUMBER
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1651

MAIL DATE	DELIVERY MODE
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05/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/615,098

Applicant(s)

DEKKER ET AL.

Examiner

Susan Hanley

Art Unit

1651

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 April 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-48.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Art Unit: 1651

Continuation of 3. Note: The addition of new limitations in claims 1, 20, 22, and 41, wherein the provided artificial media is not attractive arthropods which are parasitic to a vertebrate host, raises new considerations for search and examination. For example, if the amendment had been entered, the newly added limitations would have to be searched against the prior art. Furthermore, the inherency of the newly claimed properties as being disclosed by the currently cited references would have to be evaluated as well in order to ascertain if the prior art lipid media lacks the newly claimed attractive aspects. Hence, the non-entered amendment raises new issues for a search of new prior art as well as consideration regarding the currently cited prior art. Furthermore, the non-entered amendment fails to place the application in better for appeal because the proposed claims raise new considerations for search and examination instead of simplifying or reducing the issues.

Continuation of 11, does NOT place the application in condition for allowance because:

A. The rejection of claims 1-21 under 35 U.S.C. 112, second paragraph; and the rejection of claims 1-6, 8-27, 29-44, 46 and 47 under 35 U.S.C. 103(a) as being unpatentable over Bernier et al. (6,267,953; item 9 in the IDS filed 1/5/04) in view of Braks et al. (2000), stand because Applicant's argument entirely assumes entry of the non-entered amendment.

B. Regarding the objection to the specification as containing new matter:

Applicant argues that the variable R_{12} was disclosed by the specification as-filed "although the structural formula incorrectly recited the variable as R_2 in the original filing." Applicant asserts that the "statement immediately following said formula is, "wherein R_5 to R_{12} is selected from the group consisting of ..." is an adequate disclosure of the variable R_{12} . Applicant argues that the language describing the eight R_x variables (R_5 to R_{12}) shows that the R-groups in the structure were meant to be contiguous with those in the Markush group and that it was a typographical error such that R_2 should have been R_{12} . Applicant argues that the structure makes sense because all of the R-variables have the same meaning. Applicant concludes that changing R_2 to R_{12} does not materially change the meaning of the structure or add new matter to the specification.

Examiner Response: Responding to Applicant's argument that R_{12} was disclosed in the as-filed specification in the Markush group and any possible interpretation would not change the chemical formula of the structure, the objection made was that "The *structures* in the indicated paragraphs have been amended such that the group that was R_2 has been amended to read R_{12} " (emphasis added). While the variable R_{12} is disclosed in the Markush group, it was not disclosed in the structure as-filed. While R_2 and R_{12} might have the same meaning, R_2 is not recited in the definition for the structure in question. Responding to Applicant's argument that the amendment to the specification fixes an obvious typographical error and that it follows the alleged pattern of the variables in the Markush definition, the fact remains that R_{12} is not disclosed in the structure and arguments regarding what is obviously an error or what should be a pattern are not supported by the structure as-filed.

C. Regarding the New Matter rejection: Claims 7, 28, 45 and 48 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Art Unit: 1651

Applicant submits that no new matter has been introduced to the claims by the amendment because "any possible interpretation of the R_2 (now R_{12}) variable would not change the chemical formula of the structure at all." Applicant concludes that the amendment makes no change to the actual compound because on the numerical ordering of the R_x variables has been altered so that they make internal sense within the claims. Applicant asserts that "This is less drastic of a change than even what the Examiner admits is an allowable change." Applicant asserts that the "Examiner described how *In re Oda* permitted the change from nitrous acid to nitric acid. This change is an actual change in chemical formula, i.e., from HNO_2 to HNO_3 , as opposed to the present change where it has been shown that the chemical formula has not changed at all, only the number representing the formula." Applicant argues that "the Examiner acknowledged that the support for newly added claim limitations may be based on implicit or inherent disclosure within the specification" and submits that "whether taking Applicant's view that R_2 was merely a typographical error of omitting the initial number 1 and was intended to read R_{12} , or the Examiner's assertion that it was intended to have the meaning of R_2 in claim 6, the result is the same, R_2 or R_{12} has the meaning of Hydrogen, Alkyl or aryl.

Examiner's Response: Applicant's argument has been considered but is not found persuasive. Responding to Applicant's argument that the ordinary artisan would recognize that R_{12} was intended and that any possible interpretation for R_2 (now R_{12}) does not change the chemical formula, the fact remains that the claims (as well as the basis for the claims in the as-filed specification) provide no basis for R_{12} in the disputed structures. Hence, what was allegedly intended by the claims and supporting specification or what one may interpret is merely speculation. The specification and claims do not show the position of a variable R_{12} in the structure. Neither the claims nor the specification define the relationship of R_{12} to the rest of the compound. Changing R_2 to R_{12} introduces a concept that was not contemplated in the specification or the provisional application.

Responding to Applicant's assertion that the Examiner made a statement as to what was an "allowable change," no such statement was made. The Examiner merely provided possible interpretations or speculation as to how R_{12} in the structure could be interpreted in order to show the relationship between speculation and new matter.

Responding to Applicant's statements regarding the Examiner's alleged interpretation of *In re Oda*, and Applicant's assertion that the present change has not changed the chemical formula, only the number representing the formula," the change of R_2 to R_{12} is not simply a number change. The R-values are variables and their attachment to a chemical structure has significant meaning for the identity of that structure. Thus, Applicant's argument ignores the new matter implicitly introduced by adding a variable to a structure that was not previously present. Responding to Applicant's assertion that the Examiner asserted that R_{12} and R_2 have the same definition, the statement made in the previous Office action was that "As noted by Applicant, neither the instant specification, nor the provisional specification, support the idea that R_2 allegedly means R_{12} ." Responding to Applicant's assertion that the ordinary artisan would recognize that R_{12} was intended, this is only one possible speculation. The skilled artisan could just as easily interpret that R_2 should have the meaning set forth for the variable R_2 as in the structure of claim 6, and that in the text of original claims 7 and 28, the range R_5 to R_{12} should be R_5 to R_{11} ." Again, the meaning of a variable that does not originally appear in a structure is speculative. Whether or not the amendment was to fix a typographical error or that said amendment does not change the meaning of the claims, adding

Art Unit: 1651


a variable to a chemical structure adds a limitations that was not previously contemplated. Hence, the amendment is still deemed to be NEW MATTER.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Hanley whose telephone number is 571-272-2508. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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1651



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